

Remarks

This paper is filed in response to the Office Action mailed July 13, 2007, in which the Examiner advised that the pending claims 1-98 are subject to restriction under 35 U.S.C. § 121. For at least the reasons set forth below, Applicants traverse this restriction requirement and respectfully request reconsideration of the same.

While Applicants make no representations as to whether the claims in the nine groups identified by the Examiner are patentably distinct, Applicants respectfully submit that the criteria for a proper requirement for restriction have not been met. MPEP § 808 recites that “[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention *as claimed* is either independent or distinct from the others; and (B) the reasons why there would be a serious burden on the examiner if restriction is not required . . .”

With respect to aspect (A), the Examiner has asserted that the species are independent or distinct because “each embodiment properly claimed may be considered a separate invention.” Office Action, page 3. However, Applicants respectfully submit that this is a mere statement of conclusion, which is inadequate to meet the Examiner’s burden for requiring restriction. MPEP § 808.01 (“A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.”). No reasons are given as to why the species identified are independent or distinct from the others.

Nor could such a showing convincingly be made. Two inventions are “independent” if they are “unconnected in design, operation, and effect.” MPEP § 802.02. The species identified by the Examiner are not “independent.” Indeed, each

and every one of the pending claims is directed to “an orthopedic cutting guide device for use in resecting a portion of a bone.” Accordingly, at the very least, each of the species identified are connected in effect and operation.

With respect to aspect (B), the Office Action is silent as to the reasons why the Examiner would be seriously burdened in the absence of a restriction. According to the MPEP at Section 808.02, the Examiner, in order to meet his burden for insisting upon restriction, “must explain why there would be a serious burden on the examiner if restriction is not required.” A “serious burden” must be shown by explanation of at least one of: separate classification of the inventions; a separate status of the inventions in the art; or a different field of search for the inventions. MPEP § 808.02.

Aside from the fact that no attempt was made to establish proof of a serious burden, examination of each of the inventions identified by the Examiner could not be considered to result in a serious burden. First, the inventions are not classified separately. To the contrary, as mentioned above, each of the identified inventions is “an orthopedic cutting guide device for use in resecting a portion of a bone,” and each is therefore classified in the same field of search. Likewise, there is nothing to indicate that any of the identified inventions could be considered to have a “separate status in the art.” Finally, there is no indication that different fields of search are required for any of the identified inventions. Moreover, it would be difficult for any such showing to be made, given that the Examiner *has already performed a search and issued a substantive Office Action*. Indeed, the MPEP states that “[e]lection of species may be required **prior to a search on the merits** in applications containing claims to a plurality of species with no generic claims” MPEP § 808.01(a)

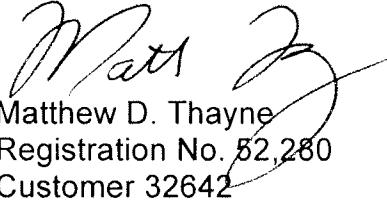
(emphasis added). The fact that such a search has already been performed cuts squarely against any claim of serious burden on the Examiner if restriction is not required.

For at least the foregoing reasons, Applicants respectfully request that the restriction requirement be withdrawn. Notwithstanding the foregoing traversal, Applicants hereby provisionally elect the invention categorized by the Examiner in group "A" and encompassed by claims 1-37.

Please contact Applicants' undersigned attorney in the event that any remaining impediment to the prompt allowance of this application is found, which could be clarified by a telephonic interview, or which may be susceptible to being overcome by means of an Examiner's Amendment.

DATED this 7TH day of August, 2007.

Respectfully submitted,


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